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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/964,751      | 09/28/2001  | Jean Mondet          | 05725.0960-00       | 3105             |

7590 09/17/2004

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| EXAMINER |
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WEBMAN, EDWARD J

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| ART UNIT | PAPER NUMBER |
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1617

DATE MAILED: 09/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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09/964751

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| EXAMINER |
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8/23/04

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/15/04

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-77 is/are pending in the application.  
Of the above, claim(s) 14-20, 22-38, 51, 56, 64, 66, 73-76 is/are withdrawn from consideration.  
☐ Claim(s) 48 is/are allowed.  
☒ Claim(s) 1-4, 10-13, 21, 39-45, 50, 52-55, 57-61, 63, 65, 67-72, 77 is/are rejected.  
☐ Claim(s) 5-9, 46, 47 is/are objected to.  
☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.  
☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.  
☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.  
☐ The specification is objected to by the Examiner.  
☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.  
☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_  
☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☒ Notice of Reference Cited, PTO-892  
☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_  
☐ Interview Summary, PTO-413  
☐ Notice of Draftsperson's Patent Drawing Review, PTO-948  
☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

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Applicant's election with traverse of Formula II with A1 = A2, <sup>a</sup> <sup>mono</sup> 1-80 (normalcoholic and D <sup>a</sup> <sup>l</sup> 36 dimer diol, parleam, pigment and a solid) in the reply filed on 6/23/03 and 7/15/04 is acknowledged. The traversal is on the ground(s) that no burden has been shown. This is not found persuasive because no burden <sup>need be</sup> ~~needs~~ <sup>be</sup> shown. On the contrary, applicants may overcome the requirement by stipulating that the species are equivalent. However, a rejection over one species shall then apply to all.

The requirement is still deemed proper and is therefore made FINAL.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 10-13, 21, 39-50, 52-55, 57-61, 63, 65, 67-72, 77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al in view of Kantner et al.

Arnaud et al claim a lipstick (claim 24). Pigments are specified (column 4 lines 63-64). Parleam is disclosed (column 5 line 45).

Kantner et al teach a polyurethane dispersion useful in cosmetics such as lipsticks for forming hydrophobic films (title, column 5, lines 29-36). H12 MD1 is specified (column 8, line 15-17). Dimer diols are disclosed (column 7, line 14). A molecular weight of 500 <sup>K</sup> is specified (column 13 line 54). Ethanol as a chain terminator is specified (column 12 lines 50-52).

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It would have been obvious to one of ordinary skill to use the dispersion of Kantner et al in the lipstick of Arnaud et al. for the beneficial effect of forming a hydrophobic Film.

As to the product by process claims, the claimed process is not considered a patentable limitation during prosecution before the USPTO.

Claim 61 is objected to because of the following informalities: In line 1 "comprising a" is indefinite. Appropriate correction is required.

Claims 5-9, 46, 47 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Webman whose telephone number is (571) 272-0633. The examiner can normally be reached on Monday to Friday 9 Am 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, S. Padmanabhan can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Webman/LR  
August 25, 2004



2004/08/25